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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,999	08/31/2000	JUN OIDA	00862.021990.	2955
5514 7590 02/07/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER EBRAHIMI DEHKORD, SAEID	
			ART UNIT 2625	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/650,999	Applicant(s) OIDA, JUN	
	Examiner Saeid Ebrahimi-dehKordy	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2007.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 69-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 69-77 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/6/07 has been entered.

***Response to Arguments***

2. Newly submitted RCE claims 69-77 filed on 6/6/07 are adding limitation which are distinct and separate inventions limitation such as, "a control unit configured to decide whether the image data of the first format or the image data of the second format converted by said conversion unit is to be transmitted by said communication unit based on a communication speed and a configuration of the printer, and to cause said communication unit to transmit the image data of the decided format to the printer." which requires more search/reconsideration.

3. Newly submitted claims 69-77 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: that the newly presented claim are claiming the different invention which is pulled from the distinct embodiments of the specification and needs further search and consideration.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

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on the merits. Accordingly, claims 69-77 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. The RCE filed on 6/6/07 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03).

The remaining claims are not readable on the elected invention because that the newly presented claim are claiming the different invention which is pulled form the distinct embodiments of the specification and needs further search and consideration.

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE

#### **DETAILED ACTION**

1. Claims 38, 51, 52, 55, 59, 60, 63-68 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 12/13/2006.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small (US 6,940,541) in view of Rissman (US 6,552,743).

**Regarding claims 62, 63:** Small teaches an image input apparatus (fig. 1, digital camera) for connecting with a printing apparatus (printer, fig. 2), the printing apparatus receives image data from an apparatus to which the printing apparatus is connected, and converts compressed image data (compressed image, column 1, lines 29, column 2, lines 25-30) into image data (processing image for print, column 1, line 31, column 2, lines 30-35) for printing to print an image, in a case that the received image data is the image data (the printer is performing the processing, column 2, lines 30-35, column 2, lines 60-67), the image input apparatus comprising: an input unit (12, fig. 1) configured to input image data; an obtaining unit (the program code that controls 24, fig. 1, column 2, lines 60-67, column 1, lines 45-55) configured to obtain type information of the printing apparatus, in response to the power on of the printing apparatus or a connection (inherently, all query and signal received must be performed in the situation of power is on and the communication devices are connected; also if the query is received by the printer, the printer is connected to the camera) between the image input apparatus and the printing apparatus; a determination unit (16, 18, fig. 1) configured to determine (column 2, lines 63-64) whether or not to convert the compressed image data (column 2, lines 28) into image data for printing (decompressed image data, column 2,

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lines 30-35) using the printing apparatus, based on the type information obtained by said obtaining unit; a conversion unit (the program that decompressed the compressed image data) configured to convert the compressed image data into the image data for printing based on a determination result by said determination unit; and a communication unit (24, fig. 1 ) configured to transmit the compressed image data or the decompressed image data for printing to the printing apparatus (depends on whether the printer or the camera processed the compressed image data, column 2, lines 30-35, column 2, lines 60-67).

Small does not teach what type of connecting device is used to connect the printer and camera and the compression format is JPEG.

Rissman teaches connecting devices used for connecting a camera and a printer using wireless (column 4, lines 65-67) devices or via a serial bus (column 4, lines 25-30, column 8, lines 10-15) and further teaches it is well known in the art that digital camera compressed image data using JPEG (column 1, lines 15-21). Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Small to include: the camera is connected to a printer by using a serial bus and the digital camera compressed image data using JPEG (column 1, lines 15-21). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Small by the teaching of Rissman because: 1) serial bus is the most widely used and reliable method of connecting digital camera and printer and would be easily available to a user through every electronic store with reasonable price and 2) JPEP is the most widely used compression method in compressing images and would have allowed the stored compressed image to be readable by most computers.

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Response to Arguments With respect to applicant's argument that the prior art does not teach a digital camera obtains type information of a printer, in response to the power on of the printer or a connection between the digital camera or a connection between the digital camera and the printer. In reply: Small, column 1, lines 50-60, clearly teaches a digital camera obtains type information of a printer; e.g., the type of printer that is having a specific media type, pixel size, print size; etc. The examiner interprets "connection" as signal is successfully being communicated between two parties. For example, two phones may be physically connected with a wire; the phones are not considered as having a "connection" if one of the phones is broken and won't be able to receive and transmit signal. Therefore, the type information can be query by the camera and sent by the Printer (column 2, lines 60-67, column 3, lines 1-5) only if there is a "connection" between the camera and the phone-in response to query signal is successfully received by the printer and type information is successfully received by the camera.

With respect to applicant's argument that the prior art does not teach "the camera determines whether or not to convert the JPEG coded image data into the image data for printing based on the type information of the printer, and converts the JPEG coded image data into the image data for printing based on a determination result and transmits the image data for printing to the printing apparatus, or transmit the JPEG coded image data to the printer if it is determined that the JPEG coded image data is not converted;" has been considered. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

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1986).

Small teaches a determination unit (16, 18, fig. 1) configured to determine (column 2, lines 63-64) whether or not to convert the compressed image data (column 2, lines 28) into image data for printing (decompressed image data, column 2, lines 30-35) using the printing apparatus, based on the type information obtained by said obtaining unit; a conversion unit (the program that decompressed the compressed image data) configured to convert the compressed image data into the image data for printing based on a determination result by said determination unit; and a communication unit (24, fig. 1) configured to transmit the compressed image data or the decompressed image data for printing to the printing apparatus (depends on whether the printer or the camera processed the compressed image data, column 2, lines 30-35, column 2, lines 60-67). Small does not teach what type of connecting device is used to connect the printer and camera and the compression format is JPEG. Rissman teaches connecting devices used for connecting a camera and a printer using wireless (column 4, lines 65-67) devices or via a serial bus (column 4, lines 25-30, column 8, lines 10-15) and further teaches it is well known in the art that digital camera compressed image data using JPEG (column 1, lines 15-21).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Small to include: the camera is connected to a printer by using a serial bus and the digital camera compressed image data using JPEG (column 1, lines 15-21). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Small by the teaching of Rissman because: 1) serial bus is the most widely used and reliable method of connecting digital camera and printer and would be easily



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available to a user through every electronic store with reasonable price and 2) JPEP is the most widely used compression method in

compressing images and would have allowed the stored compressed image to be readable by most computers.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion.

#### **CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272- 7440. The examiner can normally be reached on Mon-Fri 8:00-4:30. If attempts to reach the examiner by telephone

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are unsuccessful, the examiner's supervisor, Edward C01es can be reached on 571-272-7402.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). 2/24/07

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke at the bottom.